

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JOHN GRINKUS

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Appeal No. 96-2905  
Application No. 29/008,076<sup>1</sup>

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HEARD: October 15, 1997

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Before STONER, Chief Administrative Patent Judge and  
CAROFF, MEISTER, JOHN D. SMITH, GARRIS, HAIRSTON, STAAB,  
FLEMING, PAK, NASE and CARMICHAEL, Administrative Patent Judges.

Majority opinion by Administrative Patent Judge NASE.  
JOHN D. SMITH, Administrative Patent Judge, concurring.  
FLEMING and PAK, Administrative Patent Judges, dissenting.  
NASE, Administrative Patent Judge.

ON REQUEST FOR REHEARING

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<sup>1</sup> Attorney Docket No. 02103/236001.

Appeal No. 96-2905  
Application No. 29/008,076

This is in response to the appellant's request for rehearing<sup>2</sup> of our decision mailed December 23, 1997, wherein we affirmed the examiner's rejection of the appealed design claim under 35 U.S.C.

§ 112, second paragraph.

We have carefully considered the arguments raised by the appellant in the request for rehearing, however, those arguments do not persuade us that our decision was in error in any respect.

In the request, the appellant lists six points believed to have been misapprehended or overlooked in rendering our decision and other grounds upon which rehearing is sought. We will address each of these points in the order they are presented in the request.

First, the appellant argues that we overlooked or misapprehended that the claim under appeal points out the bounds between infringing and noninfringing conduct with

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<sup>2</sup> Filed February 27, 1998.

greater particularity by including "substantially" in the claim because the settled rule is that a design patent is infringed if the accused design is substantially the same as the design shown in the drawings.

This is essentially a rehash of arguments previously made in the brief, and has been treated on pages 22-24 of our decision. It is not apparent to us how the presence of the word "substantially" in the Gorham<sup>3</sup> test for infringement<sup>4</sup> of a design claim mandates that it is proper, within the meaning of 35 U.S.C. § 112, second paragraph, for the appellant's design claim to include the word "substantially" in the absence of some standard or guideline in the specification apprising the designer of ordinary skill just what that term encompasses.

Second, the appellant contends that we overlooked or misapprehended the point that 37 CFR § 1.153(a), cited by us on pages 12-15 of our decision in support of our position, is

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<sup>3</sup> Gorham Mfg. Co. v. White, 81 U.S. (14 Wall) 511, 528 (1872).

<sup>4</sup> In an infringement action, both parties may present evidence on the issue of whether two designs are substantially the same.

Appeal No. 96-2905  
Application No. 29/008,076

in exactly the same form as when adopted on December 22, 1959, and in force when (1) the PTO issued the at least 18,537 design patents with "substantially" in the claim since 1971, and (2) two court decisions were decided. The first point the appellant is apparently attempting to make is that the circumstance that numerous design patents issued with the word "substantially" in the claims since the inception of the rule establishes that the appellant's use of the word "substantially" is consistent with the settled practice of the PTO. The second point the appellant is apparently seeking to make is that the two court cases establish that the appellant's use of the word "substantially" does not render the claim indefinite under the second paragraph of 35 U.S.C. § 112.

As pointed out on pages 20-22 of our decision, we recognize that design patents have been issued with the word "substantially" appearing in the claim. However, the appellant has not cited any authority which holds that the issuance of a patent has any significant precedential value. In evaluating compliance with 35 U.S.C. §§ 112 and 171, each

Appeal No. 96-2905  
Application No. 29/008,076

design application must be evaluated on the record developed in the Patent and Trademark Office (PTO). See In re Gyurik, 596 F.2d 1012, 1018 n.15, 201 USPQ 552, 558 n.15 (CCPA 1979) and In re Phillips, 315 F.2d 943, 945, 137 USPQ 369, 370 (CCPA 1963). To the extent any error has been made in the rejection or issuance of claims in a particular application, the PTO and its examiners are not bound to repeat that error in subsequent applications. Accord, In re Donaldson Co., 16 F.3d 1189, 1194, 29 USPQ2d 1845, 1849 (Fed. Cir. 1994) ("The fact that the PTO may have failed to adhere to a statutory mandate over an extended period of time does not justify its continuing to do so."); In re Cooper, 254 F.2d 611, 617, 117 USPQ 396, 401 (CCPA), cert. denied, 358 U.S. 840, 119 USPQ 501 (1958) (decision in a trademark application in accordance with law is not governed by possibly erroneous past decisions of the Patent Office); In re Zahn, 617 F.2d 261, 267, 204 USPQ 988, 995 (CCPA 1980) ("[W]e are not saying the issuance of one patent is a precedent of much moment."); Ex parte Tayama, 24 USPQ2d 1614, 1618 (Bd. Pat. App. & Int. 1992) (prior issuance of patents for designs referred to as icons has no significant precedential value in evaluating compliance with 35 U.S.C. §

171). Compliance with §§ 112 and 171 requires analysis of the statutes and interpretation of case law. Mere reference to possibly contrary decisions of an examiner in other applications, applications in which the issue raised in this case was not even addressed, are not helpful in this analysis. Furthermore, as we noted on page 22 of our decision, it is debatable whether or not this data establishes that for which it is cited.

As pointed out on pages 15-19 of our decision, the cases cited by the appellant are not controlling and do not support the appellant's position because none of them addresses the issue of how inclusion of the word "substantially" in a design claim impacts upon the requirement of 35 U.S.C. § 112, second paragraph, that an inventor must particularly point out and distinctly claim what he regards as his invention.<sup>5</sup>

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<sup>5</sup> In fact, our research has not uncovered any final court or Board decision in which the issue of how inclusion of the word "substantially" in a design claim impacts upon the requirement of 35 U.S.C. § 112, second paragraph, was decided. This includes the cases cited by the examiner to support the rejection. Thus, there is no binding precedent for this panel of the Board to follow. See Ex parte Holt, 19 USPQ2d 1211, 1214 (Bd. Pat. App. & Int. 1991).

Appeal No. 96-2905  
Application No. 29/008,076

Third, the appellant argues that we overlooked or misapprehended that the PTO is acting arbitrarily and capriciously to deprive the appellant of a property right without due process of law in granting design patents to others in "the ornamental design . . . substantially as shown and described" while denying such protection to the appellants.

We respectfully disagree with the appellant on this point. In our view, the PTO in the present case has advanced convincing reasoning in support of its position which has not been rebutted by the appellants. Under these circumstances, the PTO cannot be said to be acting arbitrarily and capriciously in refusing to grant the appellant a patent. Further, and as stated above, to the extent any error has been made in the rejection or issuance of claims in a particular application, the PTO and its examiners are not bound to repeat that error in subsequent applications.

Fourth, the appellant contends that we overlooked or misapprehended the impropriety of an MPEP ruling based on

dictum in a footnote of a Board decision in conflict with authoritative rulings of binding precedent for more than a century.

This is apparently in regard to our reference on page 20 of our decision to MPEP § 1504.04, and/or to the examiner's reliance on In re Sussman, 8 USPQ2d 1443 (Bd. Pat. App. & Int. 1988) in rejecting the claim. First, we did not rely on MPEP § 1504.04 in arriving at our decision. Second, we expressly stated on page 20 of our decision that we did not rely on Sussman in arriving at our conclusion that the standing rejection is sustainable. Third, it is not clear what "binding precedent" MPEP § 1504.04<sup>6</sup> or Sussman violate.

Fifth, we simply disagree with the appellant's argument that our decision, if correct, renders thousands of unexpired design and utility patents having the word "substantially" in the claim invalid. Our decision makes no such sweeping holding. Rather, our decision stands for the proposition that

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<sup>6</sup> MPEP § 1504.04 has been revised to delete the reference to Sussman.



Appeal No. 96-2905  
Application No. 29/008,076

the definiteness of a design claim including language such as "substantially as shown and described" must be resolved in the same way definiteness issues are resolved in any other application involving words of degree, that is, on the basis of the particular facts of the involved application (i.e., on a case-by-case basis).

Finally, the appellant argues that we overlooked or misapprehended the point that the office is acting arbitrarily and capriciously to deprive the appellant of a property right without due process of law by ordering that the decision be rendered by eight additional members, none of which attended the hearing, without notice to the appellant, to effectively overturn a ruling by the majority of the three members who did attend the hearing that the decision finally rejecting the claims should be reversed.

This argument is based on the expansion of the three member panel to eleven members as set forth in footnote 1 on page 1 of our decision. Once again, we respectfully disagree with the appellant on this point for the following reasons.

Appeal No. 96-2905  
Application No. 29/008,076

In our view, the PTO in the present case had ample justification in expanding the panel. In that regard, in section (2) of the brief, the appellant identifies Application No. 07/909,057 as containing an appeal that will directly affect or have a bearing on the Board's decision in the pending appeal. The appeal in Application No. 07/909,057 involved the same issue as raised in this appeal. The decision of the examiner to reject the single design claim in Application No. 07/909,057 under 35 U.S.C. § 112, second paragraph, was affirmed by a three member panel in a decision mailed December 19, 1996 (prior to the hearing held on October 15, 1997 in this appeal) and the appellant's request for reconsideration under 37 CFR § 1.197 in Application No. 07/909,057 was denied by that panel in a decision mailed September 29, 1998.

Standard Operating Procedure 1 (Revision 6, April 1, 1997)<sup>7</sup> sets forth in section V, part A, reasons for expanding a panel. One reason listed is conflicting decisions by different panels of the Board.

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<sup>7</sup> Copy attached.

Appeal No. 96-2905  
Application No. 29/008,076

After the hearing held on October 15, 1997 in this appeal, it became apparent to the original three member panel that a decision conflicting with the decision rendered by another panel of the Board in Application No. 07/909,057 might result. In view of the possibility of issuing such a conflicting decision, in accordance with Standard Operating Procedure 1, section V, part B, second paragraph, the original three member panel brought this matter to the attention of Chief Administrative Patent Judge Stoner by suggesting the need for an expanded panel. Thereafter, Chief Administrative Patent Judge Stoner ordered that the original panel be expanded to eleven Administrative Patent Judges. Thus, Chief Administrative Patent Judge Stoner and Administrative Patent Judges Caroff, Meister, John D. Smith, Garris, Hairston, Staab and Carmichael were added to the panel for purposes of rendering a decision concerning the rejection of the single design claim under 35 U.S.C. § 112, second paragraph.

Furthermore, 35 U.S.C. § 7 (b) plainly and unambiguously requires that the Commissioner designate "at least three" Board members to hear each appeal. By use of the language "at

least three," Congress expressly granted the Commissioner the authority to designate expanded Board panels made up of more than three Board members. In re Alappat, 33 F.3d 1526, 1532, 31 USPQ2d 1545, 1547 (Fed. Cir. 1994) (en banc). As set forth by the court

There is no evidence in the legislative history of Section 7, or Title 35 as a whole, clearly indicating that Congress intended to impose any statutory limitations regarding which Board members the Commissioner may appoint to an expanded panel **or when the Commissioner may convene such a panel**.<sup>8</sup> [Alappat, 33 F.3d at 1532, 31 USPQ2d at 1548] [emphasis ours].

In Alappat the original three member panel of the Board reversed the examiner's non-statutory subject matter rejection. The examiner then requested reconsideration of this decision, pursuant to section 1214.04 of the Manual of

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<sup>8</sup> As stated in Alappat, 33 F.3d at 1532, n. 3, 31 USPQ2d at 1548, n. 3, "The Commissioner has interpreted his authority to convene an expanded panel as granting him the authority to expand a three-member panel to include additional Board members after oral hearing. See e.g., Ex parte Kuklo, 25 USPQ2d 1387, 1388 (Bd. Pat. App. & Inter. 1992) (five-member panel); Larson v. Johenning, 17 USPQ2d 1610, 1610 (Bd. Pat. App. & Inter. 1991) (five-member panel); Ex parte Lyell, 17 USPQ2d 1548, 1549 (Bd. Pat. App. & Inter. 1990) (five-member panel); Ex parte Remark, 15 USPQ2d 1498, 1498 (Bd. Pat. App. & Inter. 1990) (five-member panel); Ex parte Kumagai, 9 USPQ2d 1642, 1643 (Bd. Pat. App. & Inter. 1988) (five-member panel)."

Appeal No. 96-2905  
Application No. 29/008,076

Patent Examining Procedure (MPEP), stating that the panel's decision conflicted with PTO policy. The examiner further requested that such reconsideration be carried out by an expanded panel. An expanded eight-member panel, acting as the Board, granted both of the examiner's requests. The expanded panel (five new members and the original three members) issued a majority decision in which they affirmed the examiner's section 101 rejection, thus ruling contrary to the decision of the original three member panel. The three members of the original panel dissented on the merits for the reasons set forth in their original opinion, which they augmented in a dissenting opinion.

While Alappat never raised a due process<sup>9</sup> argument, it is our position that the expansion of the panel in this appeal did not deprive the appellant of a property right without due process of law. An appeal decided without an oral hearing will receive the same consideration by the Board of Patent Appeals and Interferences as appeals decided after oral hearing. 37 CFR

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<sup>9</sup> Alappat, 33 F.3d at 1532 n. 4, 31 USPQ2d at 1548 n. 4.

Appeal No. 96-2905  
Application No. 29/008,076

§ 1.194 (a). The eight new members of the panel gave the issue presented in this appeal the same consideration as the original three members.

In addition, as stated in Alappat, 33 F.3d at 1532, n. 2, 31 USPQ2d at 1547, n. 2,

Both this court and the Court of Customs and Patent Appeals (CCPA), one of this court's predecessors, have reviewed Board decisions rendered by panels made up of more than three Board members without questioning the validity of such panels. See e.g., Hahn v. Wong, 892 F.2d 1028, 1031, 13 USPQ2d 1313, 1316 (Fed. Cir. 1989) (seven-member panel because of significance of issues raised); In re Lundak, 773 F.2d 1216, 1219, 227 USPQ 90, 92 (Fed. Cir. 1985) (eighteen-member panel); In re Durden, 763 F.2d 1406, 1409 n.3, 226 USPQ 359, 360 n.3 (Fed. Cir. 1985) (sixteen-member panel); In re Henriksen, 399 F.2d 253, 254 n.1, 158 USPQ 224, 225 n.1 (CCPA 1968) (nine-member panel because of "the nature of the legal issues raised"). Other instances wherein the Commissioner has convened an expanded panel include Ex parte Alpha Indus. Inc., 22 USPQ2d 1851, 1852 (Bd. Pat. App. & Inter. 1992) (five-member panel); Ex parte Fujii, 13 USPQ2d 1073, 1074 (Bd. Pat. App. & Inter. 1989) (five-member panel because of significance of issue raised); Ex parte Kristensen, 10 USPQ2d 1701, 1702 (Bd. Pat. App. & Inter. 1989) (five-member panel); Ex parte Kitamura, 9 USPQ2d 1787, 1788 (Bd. Pat. App. & Inter. 1988) (five-member panel because of possible conflict in case law); Lamont v. Berquer, 7 USPQ2d 1580, 1581 (Bd. Pat. App. & Inter. 1988) (five-member panel because of novelty of issue raised); Kwon v. Perkins, 6 USPQ2d 1747, 1748 (Bd. Pat. App. & Inter. 1988) (nine-member panel because of novelty of issues raised); Ex parte Horton, 226 USPQ 697, 698 (Bd. Pat. App. & Inter. 1985) (five-member panel); Ex parte Tytgat, 225 USPQ 907, 908

Appeal No. 96-2905  
Application No. 29/008,076

(Bd. Pat. App. & Inter. 1985) (five-member panel); and Ex parte Jackson, 217 USPQ 804, 806 (Bd. Pat. App. & Inter. 1982) (nine-member panel because legal issue was one of first impression).

Thus, under these circumstances, the PTO cannot be said to be acting arbitrarily and capriciously to deprive the appellant of a property right without due process of law.

In light of the foregoing, the appellant's request for rehearing is granted to the extent of reconsidering our decision, but is denied with respect to making any change thereto.

No period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REQUEST FOR REHEARING - DENIED

BRUCE H. STONER, Jr., Chief	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
MARC L. CAROFF	)	
Administrative Patent Judge	)	
	)	BOARD OF PATENT

Appeal No. 96-2905  
Application No. 29/008,076

	)	APPEALS
	)	AND
	)	INTERFERENCES
JAMES M. MEISTER	)	
Administrative Patent Judge	)	
	)	
	)	
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	)	
BRADLEY R. GARRIS	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
KENNETH W. HAIRSTON	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	
LAWRENCE J. STAAB	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JAMES T. CARMICHAEL	)	
Administrative Patent Judge	)	



Appeal No. 96-2905  
Application No. 29/008,076

JOHN D. SMITH, Administrative Patent Judge, concurring.

I concur in the result reached by the majority, but I write separately because I believe the majority's reliance on Alappat is inapposite to the issue of concern to appellant, i.e., that the expansion of this panel has deprived appellant of a property right without due process of law. The relevant issue confronted in Alappat was whether the Alappat Board's reconsideration decision was statutorily valid under 35 U.S.C. 141 "over which the court could exercise subject matter jurisdiction pursuant to 28 U.S.C. § 1295 (a)(4)(A) (1988) and 35 U.S.C. § 141 (1988)." See Alappat, 33 F.3d at 1530, 31 USPQ2d at 1546. The issue of due process of law was not germane to the jurisdictional issue in Alappat. Thus, as stated by Judge Rich in Alappat, 33 F.3d at 1536, 31 USPQ2d at 1551:

Amicus Curiae FCBA suggests that the Commissioner's redesignation practices in this case violated Alappat's due process rights, citing *Utica Packing Co. v. Block*, 781 F.2d 71 (6th Cir. 1986). In addition, an issue was raised at oral argument as to whether the Commissioner's designation practices are governed by any provisions of the Administrative Procedure Act (APA), and if so, whether the Commissioner's actions in this case violated any of these provisions. We need not address either of these issues.

The FCBA does not have standing to make a due process argument, see *Broadrick v. Oklahoma*, 413 U.S. 601, 610 (1973) ("constitutional rights are personal and

Appeal No. 96-2905  
Application No. 29/008,076

may not be asserted vicariously") and *United Parcel Service, Inc. v. Mitchell*, 451 U.S. 56, 60 n.2 (1981) (amicus may not rely on new arguments not presented below), and Alappat has waived any due process argument by acquiescing to the Commissioner's actions in this case. Thus, there is no case or controversy before this court with respect to any alleged due process violation. There also is no case or controversy as to whether the Commissioner's actions in this case violated any provision of the APA, given that Alappat does not contest these actions, and this is not an issue which this court may raise *sua sponte*. Moreover, neither of these issues is germane to the jurisdictional issue this court raised *sua sponte*, i.e., whether the Board's reconsideration decision constituted a statutorily valid decision under 35 U.S.C. § 141 over which this court may exercise subject matter jurisdiction pursuant to 28 U.S.C. § 1294(a)(4)(A).

Here, appellant has not waived any due process argument. Nevertheless, I am not aware of any factual basis to assert that appellant's due process rights were violated by the expansion of the panel which was, to my knowledge, properly effected pursuant to the Board's Standard Operating Procedure 1 (Revision 6, April 1, 1997) by the order of Chief Administrative Patent Judge Stoner.

	) BOARD OF PATENT
	) APPEALS
JOHN D. SMITH	) AND
Administrative Patent Judge	) INTERFERENCES

Appeal No. 96-2905  
Application No. 29/008,076

Appeal No. 96-2905  
Application No. 29/008,076

FLEMING, Administrative Patent Judge, dissenting.

I continue to respectfully dissent for the reasons set forth in our dissenting opinion.

	) BOARD OF PATENT
	) APPEALS
MICHAEL R. FLEMING	) AND
Administrative Patent Judge	) INTERFERENCES

Appeal No. 96-2905  
Application No. 29/008,076

PAK, Administrative Patent Judge, dissenting.

I continue to respectfully dissent for the reasons set forth in our dissenting opinion in the earlier decision. For purposes of elucidation, however, I add the following comments on the majority's opinion.

I initially observe that the majority's decision is filled with contradictions. On the one hand, the majority states at page 8 of this decision that:

[W]e simply disagree with the appellant's argument that our decision, if correct, renders thousands of unexpired design and utility patents having the word "substantially" in the claim invalid. Our decision makes no such sweeping holding. Rather, our decision stands for the proposition that the definiteness of a design claim including language such as "substantially as shown and described" must be resolved in the same way definiteness issues are resolved in any other application involving words of degree, that is, on the basis of the particular facts of the involved application (i.e., on a case-by-case basis).

On the other hand, the majority takes the position that the use of the "substantially" language in a design application claim is **per se** indefinite. See the earlier

decision, pages 13-15. This *per se* rule approach is apparent from the majority's reliance on Rule 1.153(a), which, according to the majority, prohibits the use of "substantially" in a design claim. See the earlier decision, pages 13-15. If the majority is taking the *per se* indefiniteness approach to the term "substantially" as indicated *supra*, appellant is correct in stating that the majority's earlier decision renders thousands of unexpired design patents invalid. If the majority is taking a contrary position, i.e., a case-by-case approach to determining the definiteness of "substantially" in a design application, I do not believe that the results, i.e., invalidation of thousands of unexpired design patents, will be any different, since most, if not all, of the design patents already issued consist essentially of drawings, which, according to the majority, are not sufficient to guide the designer of ordinary skill to understand the meaning of the expression "substantially". Thus, in my view, the majority's decision constitutes improper taking of the property interests of a significant number of patentees who have relied on the guideline set forth in *Ex*

**parte Owen** referred to in the earlier dissenting opinion, without providing any constitutionally required procedural safeguards.

I also observe that the determination of indefiniteness is a question of law which can be raised **sua sponte** by courts. However, as indicated at pages 16 and 17 of the earlier decision, all of the appellate and district courts confronted with the expression "substantially" in the context of design patent claims have not held that expression to be indefinite. In my view, implicit in their decisions is that the expression "substantially" recited in design claims does not violate the second paragraph of 35 U.S.C. § 112.

Further, I take exception to the majority's reliance on **Alappat** to justify the procedural due process associated with the expansion of the original panel. I do not believe that **Alappat** is relevant to the due process issue raised by appellant for the reasons well articulated by Administrative Patent Judge John D. Smith in his concurring opinion.

Appeal No. 96-2905  
Application No. 29/008,076

**Alappat**, 33 F.3d at 1536, 31 USPQ2d at 1551. The Federal Circuit in **Alappat** simply did not analyze the impact of **Utica Packing Co. v. Block**, 781 F.2d 71 (6th Cir. 1986), which was cited by Amicus Curiae FCBA, since due process was no longer at issue before the court.

Finally, I take exception to what appears to be the majority's reliance on the SOP (standing operating procedure) to justify the procedural due process requirement raised by appellant. The majority has not established that the SOP itself complies with the procedural due process requirement, i.e., does not deprive appellant of a property right without due process of law.

	) BOARD OF PATENT
	) APPEALS
CHUNG K. PAK	) AND
Administrative Patent Judge	) INTERFERENCES



Appeal No. 96-2905  
Application No. 29/008,076

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## ON REQUEST FOR REHEARING

APPEAL NO. 96-2905 - JUDGE NASE  
APPLICATION NO. 29/008,076

APJ NASE

APJ CARMICHAEL

APJ PAK

APJ FLEMING

APJ STAAB

APJ HAIRSTON

APJ GARRIS

APJ JOHN D. SMITH

APJ MEISTER

APJ CAROFF

CAPJ STONER

DECISION: **DENIED**

Prepared By: Gloria

Henderson

**DRAFT TYPED:** 16 Oct 98  
1st Rev. 28 Oct 98

**FINAL TYPED:**

Appeal No. 96-2905  
Application No. 29/008,076